



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,164	12/17/2001	Michael Wayne Brown	AUS920010836US1	3969

7590 03/25/2005
BIGGERS & OHANIAN, PLLC
5 SCARLET RIDGE
AUSTIN, TX 78737

EXAMINER

UBILES, MARIE C

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,164

Applicant(s)

BROWN ET AL.

Examiner

Marie C. Ubiles

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on October 7, 2004 has been entered. Claims 52-69 have been amended. No claims have been cancelled. No claims have been added. Claims 1-71 are still pending in this application, with claims 1, 26, 51, 62, 70 and 71 being independent.

Claim Rejections - 35 USC § 112

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 7 recites the limitation "said callee" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-59, 62-66 and 68-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Catron et al. (US 5,018,191).

As for claims 1, Catron et al. disclose a method for determining a call backup (or automatic transfer of fax calls)(See Col.2, lines 14-19), comprising: detecting a context (or "recognizing fax calls by a special prefix or an indicator in a data message")(See

Col. 3, lines 21-23) for a call from a caller (of fax caller) to an intended callee (or called party)(See Col.2, lines 21-34); and automatically selecting at least one backup party from among a plurality of backup parties (or alternative destinations) to said intended party according to said context for said call (See Col. 6, lines 45-60 and Col. 10, lines 1-2).

As for claim 2, Catron et al. discloses receiving a request for a selection of at least one backup party (See Col. 7, lines 21-25). Regarding claim 19, the recited "leaving a message" reads on Catron's caller choosing to store and forward the sent fax message.

As for claim 4, the recited "... service executing outside a trusted telephone network handling that call" reads on, for example Fig. 1, it can be appreciated that element 102 and 104 are part of separate LECs and the fax call has to go through an intermediate switch in order for the communication to be completed (i.e. "outside a trusted telephone network").

As for claim 5, Catron et al. discloses automatically facilitating forwarding said call to said at least one backup party (See Col. 6, lines 54-56).

As for claim 6, Catron et al. discloses responsive to detecting said intended callee as unavailable (or busy), automatically facilitating transfer of said call from said intended callee to said at least one backup party (See Col. 7, lines 38-42).

As for claim 7, the recited limitation reads on Catron's et al. function of automatically storing and forwarding a fax call made to a mixed line based on a ring-no-

Art Unit: 2642

answer (or "not detecting said callee at said at least one line number")(See Col. 2, lines 17-19).

As for claim 8, the recited limitations read on the functions performed by Catron et al. in Fig. 3, element 252, the claimed "plurality of backup parties" read on element 273 of the aforementioned figure, the "filtering said plurality of backup parties..." reads on the fact that Catron's system looks for a match among the called number and the information on the database (See also, Col. 6, lines 2-60).

As for claim 10, the recited limitation is disclosed by Catron's system in Col. 6, lines 46-61.

As for claim 13, the recited "type of device utilized by said caller" reads on the use of "originating facsimile machine 101/102".

As for claim 22, the limitation "said intended callee is an individual different from a line subscriber..." may be read for example on a communication forwarded from an unanswered elderly person telephone number to the telephone of a relative or close neighbor. Such features are well known in the art (See, for example, *Harlow et al. US 5,206,901*).

Claim 24 reads, for example, on the information stored in database 250 (See Fig. 3) regarding fax call handling to a certain called party (or "a profile for said intended callee").

Claim 25 reads, for example, on the fax call being processed based on the ANI of the called party (or "identity of said intended callee").

Regarding claim 16, the Examiner takes Official Notice that the use of a "voice messaging service" being used as a backup party is well-known in the art; and may read for example on a secretary forwarding a call to his or her boss' voice mail after determining that his or her boss is not available.

Claim 26 and 51 are rejected for the same reasons as claim., the recited "context inference server" is disclose by Catron in Fig. 1, elements 156 and 250.

Claims 27, 29-33, 35, 38, 41, 44, 47 and 49-50 are rejected for the same reasons as claims 2, 4-8, 10, 13, 16, 19, 22 and 24-25, respectively.

Claims 52, 54-58 and 59-61 are rejected for the same reasons as claims 2, 4-8 and 19-21 respectively.

Claims 62, 66 and 68-69 are rejected for the same reasons as claims 7, 16 and 4-5, respectively.

Claim 70 is rejected for the same reasons as claim 5.

Claim 71 is rejected for the same reasons as claim 25, the recited "switch" reads on "local exchange switch 170".

In regards to claims 63-65, the recited "request for a line number [and/or] an intended callee", reads, for example on a calling party dialing the number of the person to which the fax –disclosed by Catron et al.- is to be sent.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 2642

7. Claims 3, 9, 11-12, 14-15, 17, 28, 34, 36-37, 39-40, 42 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catron et al. (US 5,018,191).

As for the recited limitation of claim 3, it would have been obvious to one of ordinary skill that a fax call to element 104, disclosed by Catron and performed within the "local exchange switch 170" may have detect a context for said fax call...within a trusted telephone network handling said call" (or a fax call, for example, within the same office).

Regarding the recited limitation of claim 9, Catron teaches shielding fax machines from receiving excessive junk fax messages. Based on Catron et al. teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention that fax calls not deemed "junk fax messages" (i.e. "subject matter") would be handled to a specified backup party when necessary (See Col. 6, lines 59-60).

Regarding the claimed limitation of claim 11, Catron teaches handling of fax calls according to time of the day or day of the week (See Col. 6, lines 46-61); it would have been obvious to one of ordinary skill in the art at the time of the invention that scheduling the fax calls completions around a certain time of day or day of week may be used to handle calls during, for example, meetings or holidays (i.e. "event"). Additionally, a fax message may be scheduled to be sent during off-peak hours to save on long distance charges.

As for claim 12, the limitation specifying "location of said caller" can be read on well-known features in which a call is forwarded or transferred to another party based on the calling ANI or ALI information.

As for claim 14, the recited "individual" may be read on the "customer who is served by facsimile machine 104", taught by Catron in Col. 4, lines 1-4.

Regarding claim 15, "facsimile machines" are apparatuses mainly used in the business sector, thus it would have been obvious to one of ordinary skill in the art that the recited backup party would have been a "business entity". Further, as for claim 17, it is well known in the art that facsimile machines are used for sending and receiving text and/or graphics over a telephone line, therefore a fax machine may be considered a "text messaging service".

Claims 28, 34, 36-37, 39-40 and 42 are rejected for the same reasons as claims 3, 9, 11-12, 14-15 and 17, respectively.

Claim 67 is rejected for the same reasons as claim 17.

8. Claim 18 and 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Catron et al. (US 5,018,191) in view of Kung et al. (US 6,373,817).

As for claims 18, Kung et al. teaches a "chase-me system" in which a call message may be routed by the user predetermining a prescribed date and time, an event and a schedule, data rate, and alternative network locations and terminal configurations (See *Abstract and Description*, Col. 10, lines 55-63, Col. 13, lines 7-13, Col. 30, lines 52-59, Col. 35, line 19- Col. 36, line 4).

As taught by Kung et al., the user has an ability to "leave a message or type-in a chat note". It would have been obvious to one of ordinary skill in the art that in order to send the "type-in chat note" to the backup party, the system will know what kind of device

the calling party is utilizing. The “instant messaging service” limitation may be read on the “type-in chat note” too.

Claim 43 is rejected for the same reasons as claim 18.

9. Claims 20-21 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catron et al. (US 5,018,191) in view of Slusky (US 5,487,111).

As for claims 20-21, Slusky teaches the manner in which the billing for the service is to be performed (i.e. sharing payment for telephone service costs for said call between said intended callee and said at least one backup party, and transferring a payment from said intended callee to said at least one backup party) (See *Description*, Col. 7, lines 59-64 and Fig. 5, Steps 528-530).

It would have been obvious to one of ordinary skill to modify Catron’s system as per the teachings of Slusky regarding billing of services and thus in this manner allowed the called party (or “intended callee”) to reduce costs, for example, when an unsolicited fax message is sent to the called party.

Claims 45-46 are rejected for the same reasons as claims 20-21.

10. Claim 23 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catron et al. (US 5,018,191) Hou et al. (EP 0585004).

Hou et al. discloses a system in which a subscriber may place a call to a particular location (e.g. home) based on the use of a voice identified label (i.e. context)

Art Unit: 2642

that is associated with subscriber's telephone number (i.e. detecting a context for a call from a caller to an intended callee)(See *Description, Col. 4, lines 6-25*).

As for claims 23 and 48, the limitation "said intended callee is a line subscriber..." reads into the process of "callin[ing] Dad" as disclosed by Hou et al.

Response to Arguments

11. Applicant's arguments with respect to claims 1-71 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Koohgoli et al. (US 6,091,968) teaches a call switching system based on type of call.

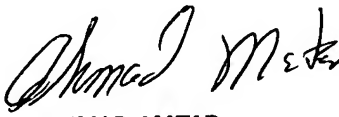
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (571)272-7491. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2642

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marie C. Ubiles
March 18, 2005.



AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600